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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,653	11/04/2003	Russell L. Davis	19536	5374

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EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/699,653

Applicant(s)

DAVIS, RUSSELL L.

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>04012004</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: the “ball portion” of the insole was denoted as reference number “6b” on page 3, paragraph [0018] lines 1-2 then later as “2b” in paragraph [0018] line 9. Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee 2003/0121177 (Lee ‘117) in view of Skaja 6,098,313. Lee’117 discloses all the limitations substantially as claimed including the following: an article of footwear for receiving a user’s foot 100” comprising an upper member 11” adapted to cover the upper portion of the user’s foot; the upper member having an open bottom defining a bottom edge portion contained in a generally horizontal plane (see Figure 7); a horizontal flexible insole member 13” arranged within and secured to the upper member bottom edge portion (see Figure 7); the insole member having generally planar upper and lower surfaces, and toe, ball, arch and heel portions arranged below the corresponding portions of the user’s foot (see Figure 7); an annular welt member 12” extending concentrically around the upper member bottom edge portion; insole stitching means 15” securing the welt member to the upper member lower edge portion and to the insole

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member; a midsole member 40" extending beneath the insole member and the welt member (See Figure 7); means 16" securing the midsole member to the welt member; an outsole member 20" extending beneath and secured to the midsole member. Lee '117 does not teach nor disclose the insole member being made of moldable material with lower surface containing beneath the ball portion of the user's foot a plurality of transversely-extending longitudinally-spaced flex grooves that define there between a plurality of transversely extending flex bars and the flex bars being parallel. Skaja '313 teaches that a portion of a sole system can be made of moldable material and that flex grooves 13 can be placed under the ball of the user's foot and longitudinally spaced to allow for better flexion of the sole with respect to the user's gait. Furthermore, Skaja '313 teaches that the bars can be placed parallel to one another (see Figures) to coincide with the natural flexion of the user's foot. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place flex grooves and form flex bars in the bottom surface of the insole of Lee '117, to allow it to better flex with respect to the natural flexion of the user's foot.

4. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above in view of Gilkerson 3,601,908. The references as applied to claim 1 above disclose all the limitations substantially as claimed except for a longitudinally bowed shank with concave and convex surfaces being located in a slot in the bottom of the insole. Gilkerson '908 teaches that an insole 10 located within a shoe can have a recess 16 located on the bottom surface where a steel shank that is curved to match that of the shoe (downwardly curved, thereby forming a convex and concave surface) to allow for the insole to be used in different shoes of varying height without effecting the gap at the back for installation of the

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shank and use of the shank to support the user's arch during use of the footwear. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place a shank in a recess in the bottom surface of the insole of the references as applied to claim 1 above, to provide for support of the user's arch in many different height shoes while still allowing flexibility of the user's foot in the forefoot area of the shoe.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above in view of Huff 5,911,491. The references as applied to claim 1 above disclose all the limitations of the claim except for the insole member having a peripheral wall with a peripheral lip portion that has the upper member lower edge portion reversely bent back inwardly beneath the insole peripheral lip portion by the welt. Huff '491 teaches that an insole can have a peripheral lip which has the upper lower bottom portion reversely bent back inwardly beneath the insole peripheral lip portion by the welt 19 to allow for the upper to be attached to the insole and aid in preventing the upper from being pulled away from the insole when weight is applied to the insole.

#### ***Allowable Subject Matter***

6. Claims 6 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

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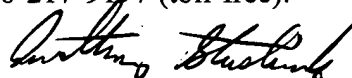
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561.

The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS